

NASA REQUEST FOR INFORMATION: NO-COST INTELLECTUAL PROPERTY MARKETING AND BROKERAGE SERVICES WITH REVENUE-SHARING COMPONENT UPON LICENSE EXECUTION

General Information

Solicitation Number:
Reference Number:
NAIS Posted Date: September 7, 2010
FedBizOpps Posted Date: September 7, 2010
Response Date: October 18, 2010
Recovery and Reinvestment Act Action? NO
Classification Code: 99 -- Miscellaneous
NAICS Code: 533110 - Lessors of Nonfinancial Intangible Assets (except Copyrighted Works)
Set-Aside Code: N/A
Internet Address:

Office Address

NASA/Goddard Space Flight Center (GSFC), NASA Headquarters Acquisition Branch, Code 210.H, Greenbelt, MD 20771

Description

This is a Request for Information (RFI) only; neither NASA nor the Government will be responsible for any costs an organization incurs in furnishing this information. NASA is requesting information from U.S. organizations interested in providing intellectual property (IP) management services (such as patent valuation, marketing, assessment and brokerage) to NASA under a no-cost arrangement that could allow for revenue sharing upon license execution. Services may be provided to one or more NASA Centers nationwide. It is NASA's intent to issue an RFP for a "no-cost" contract in the future.

NASA Patent Licensing

NASA's policy as set forth in the National Aeronautics and Space Act of 1958 and the Bayh-Dole Act of 1980, and a long history of subsequent legislation mandates NASA to seek the

widest dissemination possible of its intellectual property for commercial application and the other public benefit to the Nation. The Agency's patent licensing program is managed at each NASA Center and follows the requirements of 37 CFR §404.

(http://www.access.gpo.gov/nara/cfr/waisidx_99/37cfr404_99.html). The citation for NASA's authority to retain licensing royalty revenue is found at 15 U.S.C. 3710c.

http://www.law.cornell.edu/uscode/html/uscode15/usc_sec_15_00003710---c000-.html

Government policy is that licensing of Federally-owned inventions is to help U.S. domestic industry compete in the global marketplace and there is a preference for U.S. manufacture of licensed inventions. However, there is no prohibition on using U.S. subsidiaries of foreign owned or controlled companies. Foreign owned or subsidiary companies must demonstrate how they will handle IP issues in the global marketplace, and the steps they will take to assure U.S. manufacture of licensed inventions.

NASA Center Directors are delegated the authority to enter into patent license agreements. At most NASA Centers, the patent licensing function is currently managed by each Center with the advice and counsel of the Center's Patent Counsel and the Office of the Center Chief Technologist. The patents owned by NASA cover a broad spectrum of technologies relevant to NASA's mission and as such, represent the full breadth and scope of the work performed by the Agency.

Current Status

To make the benefit of NASA's technology investments available to the public, NASA Centers seek potential licensees for NASA-owned patent applications and patents in a variety of ways. For example, two NASA Centers are currently participating in a pilot project to transfer NASA-owned patented technologies through the live auction of exclusive licenses with pre-defined terms that the winning bidder will assume. The first such event was conducted in October 2008 and resulted in the successful auction of a portfolio of NASA-owned patents provided by the NASA Goddard Space Flight Center (GSFC). Under the same pilot program, additional live auctions were held for a portfolio of patents provided by the NASA Marshall Space Flight Center (MSFC). However, no NASA property was sold or transferred at those events.

The business model for this pilot project is revenue sharing from the licensing revenue (fees and royalties) and is thus commission-based.

NASA's Goal

NASA wishes to maximize the benefit to the public from NASA's R&D investments that yield commercially valuable technologies. Seeking no-cost methods to further advance the transfer of NASA-owned patent applications and patents will introduce efficiencies and provide increased value to the public and NASA through the introduction of new and effective licensing processes and tools. NASA recognizes that there are many business models in the U.S. for providing IP transaction services, such as patent brokering, using a variety of different transaction methods and platforms. NASA is issuing this RFI in an effort to better understand the full range of possible models and services available from U.S. entities for assisting NASA with the transfer of

NASA patented technology, at no additional cost to the taxpayer.

Request for Information

NASA is soliciting information from interested potential sources of IP management services that could be provided at no cost to NASA. NASA is specifically interested in the following information. Submitting organizations are encouraged to address as many of the bullet points and additional questions below as possible:

- The types of services envisioned that your organization might be interested in providing to NASA, including but not limited to: marketing of NASA-owned patents, mining NASA's patent portfolio to identify patent bundles, valuation of patents and patent bundles and identifying, screening, and recommending selecting qualified potential licensees, and any other services the submitting organization deems appropriate to achieve NASA's goal of increasing technology transfer to the public.
- How these services would advance NASA's goal of seeking the widest possible dissemination of its IP for the benefit of the public and U.S. economy. Specifically, how would the services your organization would provide assure NASA that entities would not exclusively license bundles of patented technologies that would not be put into commercial practice?
- Identification of services that may be relevant to exclusive licenses and/or non-exclusive licenses.
- The capabilities and particular strengths of your organization in providing IP marketing and brokerage services, including your network of patent aggregators, corporate customers.
- The variety of methods your organization would use to provide these services
- The success rates and experience to date with each of the methods your organization would use, as well as some illustrative examples of each.
- Relevant experiences or lessons learned in providing similar services to Federal Government Agencies. Please identify the Agencies and the points of contact.
- Relevant experiences or lessons learned in providing similar services to other organizations. Please identify the organizations and points of contact.
- Given that NASA patents are held individually at each of the 10 NASA Centers, what are the methods your organization has used/would use to identify and evaluate patents and bundles of patents across multiple organizations, in this case, from one Center or from across multiple Centers? Please characterize the amount of information and support that would be required from NASA staff to conduct such an evaluation.

- Please briefly address the analytical methods your organization might use in providing these services.
- A summary of the resources that your organization could provide to NASA as part of a potential service, including networks, the background and experience of personnel, portfolio strengths, and any facilities, equipment or other assets that might be used to support NASA.
- Potential methods or models for delivering services, and the source and amount of non-NASA revenue that would be available to your organization for doing this work.
- Description of the potential contractual relationship with NASA and methods for complying with relevant Federal Government regulations and policies.
- If your company is a foreign-owned company or a subsidiary of a foreign-owned company, please demonstrate how your company will handle IP issues in the global marketplace, and the steps you will take to assure U.S. manufacture of licensed inventions.

Additional Questions:

- How would your organization measure success? Over what duration? Using what tools? What metrics would be used to demonstrate success?
- How does your organization currently manage its business? Portfolio approach? By technology area? By client base? Other?
- Please provide brief background information on the nature of your organization's business and business operations. Please include company strengths, particularly regarding marketing of IP. Also include relevant clients and types of services provided to those clients and the number of years that your organization has provided these services.
- What are the relevant strengths of your organization?
- If you were advising the Government, what approach would you recommend using to assure that the government's IP finds the widest dissemination possible of its IP for the benefit of the public and U.S. economy?
- Does your organization have any other suggestions for NASA as the Agency embarks on this project?

Any services that may potentially be provided under contracts with NASA would be on a non-exclusive basis, with NASA retaining the right to pursue other methods for technology transfer that are in the best interest of NASA and the public.

Information Submittals:

Organizations interested in providing the above information should submit the information in 20 pages or less, (excluding brochures) to the address shown below by October 15, 2010, E-DT. Use single space, 12 –point, Times New Roman format.

The following file naming convention should be used: IPP_RFI_company name.doc. For example, Ford would name its file IPP_RFI_Ford.doc.

Authorized file formats include: Adobe Acrobat versions 6-8(.pdf) Microsoft Word versions 2000-2007 (.doc) and Microsoft Excel versions 2000-2003 (.xls).

Although all submissions received will be carefully reviewed and considered for inclusion in any possible later action, NASA does not commit to adopt or include any particular recommendations in a subsequent document (e.g., a solicitation). Respondents will not be notified of the results of the review.

No solicitation exists; therefore, do not request a copy of the solicitation. If a solicitation is released it will be synopsisized in the FedBizOpps and on the NASA Acquisition Internet Service. It is the responsibility of potential offerors/bidders to regularly monitor these sites for the release of any solicitation or synopsis.

Response Submission Deadline:

Responses to this RFI must be submitted no later than 11:59 PM Eastern Daylight Time, on October 18, 2010. RFI submissions will be accepted as email attachments only. All responses must be sent to HQ-IPP-RFI@mail.nasa.gov with “IPP RFI Response” in the subject line.

An email confirmation of receipt from NASA will be sent within a one-week period to the designated point of contact.

Point of Contact for Inquiries and Submissions:

Inquiries regarding this RFI may be directed to NASA Headquarters, Office of Innovative Partnerships, Mail Stop 6F80, 300 E Street SW, Washington, D.C., 20546, fax 202-358-3878, telephone (toll free) 1-877-202-7109, or electronic mail at HQ-IPP-RFI@mail.nasa.gov with “IPP RFI Inquiry “ in the subject line. Inquiries must be received within 15 calendar days from the date the RFI is issued. Responses to all inquiries received by this deadline will be posted electronically and made publicly available at http://www.nasa.gov/offices/ipp/partnership_devel/new_innovative_partnerships/rfi_detail.html within 30 calendar days from the date this RFI is issued.

This synopsis is for information and planning purposes only and is not to be construed as a commitment by the Government and the Government will not pay for information solicited.

Final RFI

Disclaimer:

NASA will not publicly disclose proprietary information obtained as a result of the RFI. To the full extent that it is protected by law and regulations, information properly identified by a respondent as Proprietary or Confidential will be kept confidential.

This RFI may also be found electronically at

http://www.nasa.gov/offices/ipp/partnership_devel/new_innovative_partnerships/rfi_detail.html .

Point of Contact

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